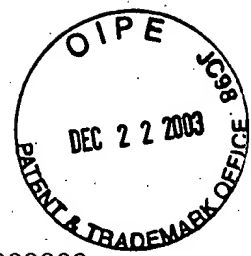


IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



In re Patent Application of : ) Attorney Docket No. 53326.000008  
Stephen W. COMISKEY *et al* ) Group Art Unit: 3629  
Serial No: 09/520,763 ) Examiner: Debra F. Charles  
Filed: March 8, 2000 ) Confirmation No. 1661

#18

For: SYSTEM AND METHOD FOR PROVIDING  
FINANCIAL SERVICES TO HIGH NET WORTH INDIVIDUALS

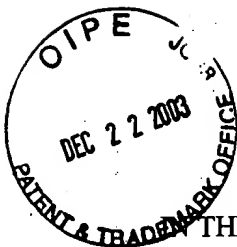
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**APPEAL BRIEF**

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**APPEAL BRIEF**

Appellants' Appeal Brief in connection with the above-captioned patent application is hereby submitted in triplicate. A check for the requisite fee in accordance with 37 C.F.R. § 1.17(c) is enclosed. A Notice of Appeal was filed on October 29, 2003. It is respectfully submitted that this Appeal Brief is timely filed. Each item required by 37 C.F.R. § 1.192 is set forth below. Appellants believe that no additional fees are deemed necessary, however if there are any deficiencies, please charge the undersigned's Deposit Account No. 50-0206.

In response to the Office Action dated September 16, 2003, rejecting pending claims 58-75, Appellants respectfully request that the Board of Patent Appeals and Interferences reconsider and withdraw the rejection of record, and allow the pending claims, which are attached hereto as Appendix A.

**I. REAL PARTY IN INTEREST**

The real party in interest is Stephen W. Comiskey and Timothy H. Meyers, the named inventors of the above-referenced application.

**II. RELATED APPEALS AND INTERFERENCES**

To the best of Appellants' knowledge, there are no related Appeals or Interferences.

**III. STATUS OF CLAIMS**

Claims 58-75 are pending in the application. The rejections of each of claims 58-75 are appealed.

**IV. STATUS OF AMENDMENTS**

No amendments to the claims have been filed subsequent to the rejection dated September 16, 2003.

**V. SUMMARY OF INVENTION**

The embodiments of the present inventions relate to a system and method for managing financial assets and providing a comprehensive set of services to high net worth individuals. For example, the services may be provided through a graduated series of service-provider groupings, categorized according to frequency of need and value provided. A graduated, or hierarchical, series of service provider groupings may include core service providers, an affiliated network of service providers and non-affiliated service providers. Services most common to clients, and those providing the most value to high-net-worth individuals may be included in the core service provider group. Conversely, services least common between clients, and those providing the smallest marginal value to clients may be included in the non-affiliated service provider group. The affiliated service provider group is for services that fall between the other two groupings. Such a method is efficient, because it affords the highest degree of control over the most

valuable services and resources. At the same time, it provides no restriction on the type of services that can be offered.

An embodiment of the claimed inventions are directed to a computer implemented method and system for providing personalized financial services to a client comprising the steps of: (a) receiving client data from the client comprising at least one client goal and a client portfolio at a depository; (b) assessing the client portfolio based at least in part on the client goal; (c) assigning a plurality of services to a plurality of service provider groups, further comprising the steps of: (i) determining whether each service is needed by the client on a frequent basis; (ii) determining whether a level of value to the client is above a predetermined level; and (iii) categorizing the plurality of services into a core service provider group, an affiliated service provider group and a non-affiliated service provider group, wherein the step of categorizing is based at least in part on the steps of determining wherein the steps of assessing and assigning are performed at a server; and (d) providing services in a hierarchical manner from the core service provider group, the affiliated service provider group and the non-affiliated service provider group in response to the received client data through a display.

## VI. ISSUES

The issues on appeal are as follows.

A. Whether claims 58-64, 66-72 and 74-75 are unpatentable under 35 U.S.C. § 103(a) by U.S. Patent No. 6,430,542 to Moran ("Moran"), U.S. Patent No. 5,918,207 to McGovern *et al* ("McGovern") and the VIP Forum, Fact Brief, Family Services, February 2000 ("VIP Forum").

B. Whether claims 65 and 73 are unpatentable under 35 U.S.C. § 103(a) by Moran, McGovern and VIP Forum, as applied to claims 58 and 66, and further in view of Bruce Upbin, "Old Money Chasing New," Forbes, June 15, 1998, vol. 161 issue 12 ("Upbin").

## **VII. GROUPING OF CLAIMS**

None of the claims stand or fall together. The reasons why each claim is separately patentable are presented in the Arguments section below.

## **VIII. ARGUMENTS**

The rejections against all of the pending claims under consideration in the above-captioned patent application should be reversed for the reasons set forth below.

### **A. Brief Description of the Art Applied to the Claims**

#### U.S. Patent No. 6,430,542A to Moran

Moran appears to be directed to a computer-implemented program for financial planning and advice. With the financial and advice system of Moran, an advisor can analyze a client's relationship(s) with his/her family, business and pension to provide overall financial planning and security. In particular, the financial planning invention of Moran is directed to simulating the steps required to settle a person's estate from the moment of death until all property, net of costs and taxes, is suitably distributed to survivors.

#### U.S. Patent No. 5,918,207 to McGovern *et al*

McGovern appears to be directed to a process and system for predictive resource planning to allow a service provider to meet a customer's predicted technical resource requirements. McGovern involves determining a service providers' technology baseline, determining a customer's technology direction; and predicting the customer's technical resource

requirements. The skill levels of candidate employees are documented and the candidates meeting the predicted technical resource requirements are selected.

McGovern provides automatic searches of numerous candidates' skill levels to match candidates to the customer's technical skill needs. By presenting a candidate list, intended to meet a customer's skill requirements, in a sequence ranging from most to least qualified, the invention of McGovern purports to allow a service provider to immediately assess its ability to meet a customer's requirements in a given time frame. Thus, the invention of McGovern reduces the time involved in identifying the best suited candidates by allowing a quick ranking relative to a customer's needs without having to return to a review of resumes and risk misinterpreting certain skills.

VIP Forum, Fact Brief, Family Services, February 2000

VIP Forum provides results from interviews conducted with officials at financial institutions regarding their provision of services to wealthy families. As part of the research, VIP forum discusses services designed to service family wealth. The research recognizes that as each client requires specific services, a financial institution draws only from specialists that are expert in providing relevant services.

**B. Summary of Argument**

Claims 58-64, 66-72 and 74-75 are improperly rejected under 35 U.S.C. § 103(a) by U.S. Patent No. 6,430,542 to Moran ("Moran"), U.S. Patent No. 5,918,207 to McGovern *et al* ("McGovern") and the VIP Forum, Fact Brief, Family Services, February 2000 ("VIP Forum")

because the Office Action fails to set forth a *prima facie* case of obviousness. Further, McGovern and VIP Forum fail to teach the deficiencies of Moran.

Claims 65 and 73 are improperly rejected under 35 U.S.C. § 103(a) by Moran, McGovern and VIP Forum, as applied to claims 58 and 66, and further in view of Bruce Upbin, "Old Money Chasing New," Forbes, June 15, 1998, vol. 161 issue 12 ("Upbin") because the Office Action fails to set forth a *prima facie* case of obviousness. Further, McGovern, VIP Forum and Upbin fail to teach the deficiencies of Moran.

**C. Independent Claims 58 and 66 are Patentable Over Moran, McGovern and VIP Forum**

Moran appears to be directed to a computer-implemented program for financial planning and advice. With the financial and advice system of Moran, an advisor can analyze a client's relationship(s) with his/her family, business and pension to provide overall financial planning and security. The Office Action admits the major deficiencies of Moran (page 5, Office Action mailed September 16, 2003). In other words, the Office Action admits that out of the seven major elements of claims 58 and 66, Moran fails to disclose five of them. More specifically, the Office Action acknowledges that Moran fails to show the features directed to: (c) *assigning a plurality of services to a plurality of service provider groups*, further comprising the steps of: (i) *determining whether each service is needed by the client on a frequent basis*; (ii) *determining whether a level of value to the client is above a predetermined level*; and (iii) *categorizing the plurality of services into a core service provider group, an affiliated service provider group and a non-affiliated service provider group, wherein the step of categorizing is based at least in part on the steps of determining wherein the steps of assessing and assigning are performed at a server*; and (d) *providing services in a hierarchical manner from the core service provider*



*group, the affiliated service provider group and the non-affiliated service provider group in response to the received client data through a display, as recited in independent claim 58.*

Corresponding limitations are recited in independent system claim 66.

Recognizing the significant deficiencies of Moran, the Office Action then asserts that McGovern combined with VIP Forum allegedly disclose the missing five out of seven major elements from Moran, without any proper motivation to combine. The Office Action alleges that McGovern discloses automatic searches of candidates to match customer's needs and present the candidates in ranking order relative to the client's needs. The Office Action proceeds to assert that VIP Forum determines needs and makes assignments and referrals. In light of the alleged ranking feature of McGovern and VIP Forum, the Office Action finds motivation based on obtaining "a cost-efficient way of providing referrals to various professionals and specialists."

McGovern appears to be directed to a process and system for predictive resource planning to allow a service provider to meet a customer's predicted technical resource requirements. McGovern involves determining a service providers' technology baseline, determining a customer's technology direction; and predicting the customer's technical resource requirements. The skill levels of candidate employees are documented and the candidates meeting the predicted technical resource requirements are selected.

More specifically, McGovern teaches matching candidates based on customer requirements or a generic technical profile (McGovern, col. 10, line 60 - col. 11, line 2). The system of McGovern allows the service provider to run a search within a repository of candidates according to specified selection criteria, such as particular technical profile, proficiency level at a certain skill, or a minimum number of skills to match (McGovern, col. 11, lines 5-10). The

search can combine these, and other, search criteria to narrow the candidate selection pool (McGovern, col. 11, lines 10-11). The matching process enables the service provider to identify potential candidates having a minimum level of core skills for a particular technical profile or specific customer requirement (McGovern, col. 11, lines 12-15).

The invention of McGovern is completely unrelated to providing personalized financial services to a client, as claimed by Appellants. Rather McGovern is directed to a training process to enable a service provider to anticipate and develop the service provider's personnel to meet business requirements based on the customer's technology direction (McGovern, col. 3, lines 24-29). Further, McGovern is concerned with ensuring timely availability of adequately trained personnel (McGovern, col. 3, lines 29-34).

While admitting that McGovern is non-analogous art (page 4 of Office Action mailed 9/16/03), the Office Action asserts that skill levels of employees and candidates meeting the predicated technical requirements *parallel* Appellants claimed limitations (page 3 of Office Action mailed 9/16/03). McGovern teaches the ability to run a search within a repository of candidates according to specified selection criteria, such as particular technical profile, proficiency level at a certain skill, or a minimum number of skills to match for ensuring timely availability of adequately trained personnel. The claim limitations recite determining whether each service is needed by the client on a frequent basis and determining whether a level of value to the client is above a predetermined level and further categorizing the plurality of services into a core service provider group, an affiliated service provider group and a non-affiliated service provider group. There is no perceived parallel between the two concepts. Notwithstanding the clear differences, for a proper rejection under 35 U.S.C. § 103, the combination of references

must do more than merely parallel the claimed limitations. Rather, the reference teachings must somehow be modified in order to meet each and every claim limitation. The combination proposed by the Office Action fails to meet the combination of claimed limitations.

There is no teaching or suggestion of the admitted missing elements of Moran. More specifically, McGovern makes absolutely no mention and provides no teaching of “assigning a plurality of services to a plurality of service provider groups, further comprising the steps of: (i) *determining whether each service is needed by the client on a frequent basis*; (ii) *determining whether a level of value to the client is above a predetermined level*; and (iii) *categorizing the plurality of services into a core service provider group, an affiliated service provider group and a non-affiliated service provider group, wherein the step of categorizing is based at least in part on the steps of determining.*” In addition, McGovern fails to teach or show “providing services in a hierarchical manner from the core service provider group, the affiliated service provider group and the non-affiliated service provider group in response to the received client data through a display.” At least these limitations are not taught by McGovern. In fact, the Office Action makes fails to show any teaching or disclosure in McGovern that addresses the combination of claim limitations. It is clear that McGovern’s alleged ranking feature does not obviate the combination of claim limitations.

Recognizing that McGovern fails to teach at least these missing limitations, the Office Action relies on a third reference, the VIP Forum. The Office Action alleges that the VIP forum shows that the lead relationship manager determines the professionals that the high net worth individual needs and makes these assignments and referrals. The VIP Forum provides a listing of services provided by different banks. The banks draw from specialists, as each client requires

specific services and as the needs of the client families change. The VIP Forum, at most, teaches that as the client's needs change, services received by the client also change accordingly. However, the VIP Forum nevertheless fails to provide any specific teaching directed to making a determination concerning whether each service is need by the client on a frequent basis and whether a level of value to the client is above a predetermined level. More specifically, the VIP Forum fails to provide any disclosure directed to determining *whether each service is needed by the client on a frequent basis and whether a level of value to the client is above a predetermined level* and further *categorizing the plurality of services into a core service provider group, an affiliated service provider group and a non-affiliated service provider group, wherein the step of categorizing is based at least in part on the steps of determining*. There is absolutely no disclosure or teaching that meets these qualitative analysis steps as defined by one aspect of the claims.

Finally, the Office Action justifies the combination of Moran, McGovern and the VIP Forum on an alleged motivation based on obtaining "a cost-efficient way of providing referrals to various professionals and specialists." This alleged statement of motivation is not based on any of the teaching references or generally available knowledge. It is unclear how combining Moran, McGovern and the VIP Forum is cost-efficient for providing referrals to various professionals and specialists when this is not a concern or a recognized problem in the Moran reference.

**D. The Combination of References is Based Purely on Improper Hindsight**

The rejection over Moran, McGovern and VIP Forum is a classic example of hindsight reconstruction that is contrary to the law. Controlling Federal Circuit and Board precedent require that the Office Action set forth specific and particularized motivation for one of ordinary skill in the art to modify a primary reference to achieve a claimed invention. *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 664 (Fed. Cir. 2000) (“[t]o prevent a hindsight-based obviousness analysis, [the Federal Circuit has] clearly established that the relevant inquiry for determining the scope and content of the prior art is whether there is a reason, suggestion, or motivation in the prior art or elsewhere that would have led one of ordinary skill in the art to combine the references.”). Here, the Office Action combines three disparate references, each of which are directed to different goals, to allegedly yield the independent claims.

The Office has failed to set forth a *prima facie* case of obviousness for the independent claims. Additionally, it does not even attempt to establish a *prima facie* case of obviousness for the further modifications proposed to yield the dependent claims either. Furthermore, the fact that three disparate references are needed in combination to address Appellants’ claimed invention further supports a finding of non-obviousness. The suggestion to combine becomes less plausible when the necessary elements can only be found in a large number of references. Donald S. Chisum, *Chisum on Patents* §5.04[I][e][6] (2002).

Specifically, when a primary reference is missing elements, the law of obviousness requires that the Office set forth some motivation why one of ordinary skill in the art would have been motivated to modify the primary reference in the exact manner proposed. *Ruiz*, 234 F.3d at 664. In other words, there must be some recognition that the primary reference has a problem

and that the proposed modification will solve that exact problem. All of this motivation must come from the teachings of the prior art to avoid impermissible hindsight looking back at the time of the invention.

In the present case, the Office Action's sole justification for modifying Moran in view of McGovern and VIP Forum has absolutely nothing to do with the deficiencies of Moran. Moran is alleged to teach a computer-implemented program for financial planning and advice system, but lacks any disclosure related to assigning a plurality of services to a plurality of service provider groups involving the steps of determining whether each service is needed by the client on a frequency basis, determining whether a level of value to the client is above a predetermined level; and categorizing the plurality of services into a core service provider group, an affiliated service provider group and a non-affiliated service provider group, wherein the step of categorizing is based at least in part on the steps of determining, as admitted by the Office Action (page 5, Office Action mailed September 16, 2003). Moreover, Moran lacks providing services in a hierarchical manner from the core service provider group, the affiliated service provider group and the non-affiliated service provider group. To properly modify Moran to correct for these major deficiencies, the Office has the burden to show some motivation why providing those elements would have overcome some perceived problem with Moran. Any such motivation is completely lacking.

Accordingly, the Office has failed to provide any proper motivation for modifying Moran in view of McGovern and VIP Forum, so the proposed three-reference combination fails. Even if these disparate references could be combined, the resulting combination fails to show each and every limitation claimed by Appellants.

The Office Action fails to show any motivation as to why one of ordinary skill in the art would have been motivated to combine the computer-implemented program of Moran with the predictive resource planning system of McGovern and further combined with the services of VIP Forum. The mere fact that three references can be combined or modified does not render the resultant combination or modification obvious unless there is a suggestion or motivation found somewhere in the prior art regarding the desirability of the combination or modification. *See* M.P.E.P § 2143.01; *see also In re Mills*, 16 U.S.P.Q.2d 1430, 1432 (Fed. Cir. 1990); *In re Fritz*, 23 U.S.P.Q.2d 1780 ( Fed. Cir. 1992). In addition, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Appellants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

In *In re Hedges*, 783, F.2d 1038, 1041, 228 U.S.P.Q. 685, 687, (Fed. Cir. 1986), the U.S. Court of Appeals for the Federal Circuit stated that "the prior art as a whole must be considered. The teachings are to be viewed as they would have been viewed by one of ordinary skill." The court also stated that "[i]t is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art" (quoting *In re Wesslau*, 353 F.2d 238, 241, 147 U.S.P.Q. 391, 393 (CCPA, 1965)).

**E. Claims 59-64, 67-72, 74 and 75 are Separately Patentable over Moran, McGovern and VIP Forum**

Claims 59-64, 67-72, 74 and 75 all depend ultimately from one of independent claims 58 and 66. As such, each of these dependent claims contain each of the features recited in the independent claims. For the reasons stated above, Moran combined with McGovern and further combined with VIP Forum fail to disclose the claimed inventions and the rejections should be withdrawn. Additionally, these claims are separately patentable over Moran, McGovern and VIP Forum for at least the reasons stated below.

Claim 59 is separately patentable because Moran, McGovern and VIP Forum also fails to disclose where the core service provider group represents services needed by the client on a frequent basis or having a level of value above the predetermined level indicating a primary level of service. The Office Action's rejection of this claim is improper for the reasons set forth above with respect to claim 58. The combination of Moran, McGovern and VIP Forum fails to show each and every limitation of claim 59. In addition, there is no teaching or motivation to modify Moran, McGovern and VIP Forum to include this feature.

Claim 60 is separately patentable because Moran, McGovern and VIP Forum also fails to disclose wherein the non-affiliated service provider group represents services needed by the client on an infrequent basis or having a level of value below the predetermined level indicating a secondary level of service. The Office Action's rejection of this claim is improper for the reasons set forth above with respect to claim 58. The combination of Moran, McGovern and VIP Forum fails to show each and every limitation of claim 60. In addition, there is no teaching or motivation to modify Moran, McGovern and VIP Forum to include this feature.



Claim 61 is separately patentable because Moran, McGovern and VIP Forum also fails to disclose wherein the affiliated service provider group represents services that do not fall within the core service provider group and the non-affiliated service provider group indicating an intermediary level of service. The Office Action's rejection of this claim is improper for the reasons set forth above with respect to claim 58. The combination of Moran, McGovern and VIP Forum fails to show each and every limitation of claim 61. In addition, there is no teaching or motivation to modify Moran, McGovern and VIP Forum to include this feature.

Claim 62 is separately patentable because Moran, McGovern and VIP Forum also fails to disclose wherein the core service provider group represents services most common to the client or providing most value to the client. The Office Action's rejection of this claim is improper for the reasons set forth above with respect to claim 58. The combination of Moran, McGovern and VIP Forum fails to show each and every limitation of claim 62. In addition, there is no teaching or motivation to modify Moran, McGovern and VIP Forum to include this feature.

Claim 63 is separately patentable because Moran, McGovern and VIP Forum also fails to disclose wherein the nonaffiliated service provider group represents services least common to the client or providing a small value to the client. The Office Action's rejection of this claim is improper for the reasons set forth above with respect to claim 58. The combination of Moran, McGovern and VIP Forum fails to show each and every limitation of claim 63. In addition, there is no teaching or motivation to modify Moran, McGovern and VIP Forum to include this feature.

Claim 64 is separately patentable because Moran, McGovern and VIP Forum also fails to disclose wherein services from the core service provider group are presented to the client; wherein services from the affiliated service provider group and services from the non-affiliated

service provider group are presented after the services from the core service provider group are first presented. The Office Action's rejection of this claim is improper for the reasons set forth above with respect to claim 58. The combination of Moran, McGovern and VIP Forum fails to show each and every limitation of claim 64. In addition, there is no teaching or motivation to modify Moran, McGovern and VIP Forum to include this feature.

Claim 67 is separately patentable because Moran, McGovern and VIP Forum also fails to disclose wherein the core service provider group represents services needed by the client on a frequent basis or having a level of value above the predetermined level indicating a primary level of service. The Office Action's rejection of this claim is improper for the reasons set forth above with respect to claim 66. The combination of Moran, McGovern and VIP Forum fails to show each and every limitation of claim 67. In addition, there is no teaching or motivation to modify Moran, McGovern and VIP Forum to include this feature.

Claim 68 is separately patentable because Moran, McGovern and VIP Forum also fails to disclose wherein the non-affiliated service provider group represents services needed by the client on an infrequent basis or having a level of value below the predetermined level indicating a secondary level of service. The Office Action's rejection of this claim is improper for the reasons set forth above with respect to claim 66. The combination of Moran, McGovern and VIP Forum fails to show each and every limitation of claim 68. In addition, there is no teaching or motivation to modify Moran, McGovern and VIP Forum to include this feature.

Claim 69 is separately patentable because Moran, McGovern and VIP Forum also fails to disclose wherein the affiliated service provider group represents services that do not fall within the core service provider group and the non-affiliated service provider group indicating an

intermediary level of service. The Office Action's rejection of this claim is improper for the reasons set forth above with respect to claim 66. The combination of Moran, McGovern and VIP Forum fails to show each and every limitation of claim 69. In addition, there is no teaching or motivation to modify Moran, McGovern and VIP Forum to include this feature.

Claim 70 is separately patentable because Moran, McGovern and VIP Forum also fails to disclose wherein the core service provider group represents services most common to the client or providing most value to the client. The Office Action's rejection of this claim is improper for the reasons set forth above with respect to claim 66. The combination of Moran, McGovern and VIP Forum fails to show each and every limitation of claim 70. In addition, there is no teaching or motivation to modify Moran, McGovern and VIP Forum to include this feature.

Claim 71 is separately patentable because Moran, McGovern and VIP Forum also fails to disclose wherein the nonaffiliated service provider group represents services least common to the client or providing a small value to the client. The Office Action's rejection of this claim is improper for the reasons set forth above with respect to claim 66. The combination of Moran, McGovern and VIP Forum fails to show each and every limitation of claim 71. In addition, there is no teaching or motivation to modify Moran, McGovern and VIP Forum to include this feature.

Claim 72 is separately patentable because Moran, McGovern and VIP Forum also fails to disclose wherein services from the core service provider group are presented to the client; wherein services from the affiliated service provider group and services from the non-affiliated service provider group are presented after the services from the core service provider group are first presented. The Office Action's rejection of this claim is improper for the reasons set forth above with respect to claim 66. The combination of Moran, McGovern and VIP Forum fails to

show each and every limitation of claim 72. In addition, there is no teaching or motivation to modify Moran, McGovern and VIP Forum to include this feature.

Claim 74 is separately patentable because Moran, McGovern and VIP Forum also fails to disclose one or more of a tool for mining data and a synthetic logic tool for assessing the client portfolio. The Office Action's rejection of this claim is improper for the reasons set forth above with respect to claim 66. The combination of Moran, McGovern and VIP Forum fails to show each and every limitation of claim 74. In addition, there is no teaching or motivation to modify Moran, McGovern and VIP Forum to include this feature.

Claim 75 is separately patentable because Moran, McGovern and VIP Forum also fails to disclose wherein the synthetic logic tool converts data into useful information related to the at least one client goal. The Office Action's rejection of this claim is improper for the reasons set forth above with respect to claim 66. The combination of Moran, McGovern and VIP Forum fails to show each and every limitation of claim 75. In addition, there is no teaching or motivation to modify Moran, McGovern and VIP Forum to include this feature.

**F. Claims 65 and 73 are Separately Patentable over Moran, McGovern and VIP Forum and further in view of Upbin**

Claims 65 and 73 are presently rejected under 35 U.S.C. § 103(a) as being unpatentable over Moran, McGovern and VIP Forum, as applied to claims 58 and 66, and further in view of Bruce Upbin, "Old Money Chasing New," Forbes, June 15, 1998, vol. 161 issue 12 ("Upbin"). For at least the reasons stated above, the combination of Moran, McGovern and the VIP Forum fail to show the combination of claim limitations as applied to claims 58 and 66. As claims 65 and 73 encompass the limitations of claims 58 and 66, respectively, these claims are patentable

and the rejection should be withdrawn. Further, the Upbin article fails to make up the deficiencies of the combination as applied to claims 58 and 66.

Upbin fails to address the deficiencies of Moran, McGovern and the VIP Forum. Furthermore, the Office Action has failed to provide a proper basis for combining four disparate references. For at least these reasons, the rejection is improper and should be withdrawn.

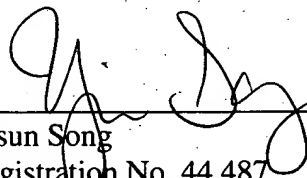
The cited references fail to show, teach or make obvious the invention as claimed by Appellants. Further, none of the references cited anticipate nor make obvious the invention as presently claimed. For at least the reasons presented above, the rejection should be withdrawn.

**IX. CONCLUSION**

In view of the foregoing, Appellants respectfully request that the Board reverse the prior art rejections set forth in the Office Action and allow all of the pending claims.

Respectfully submitted,

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Dated: December 22, 2003

**APPENDIX A - PENDING CLAIMS****CLAIMS**

Claims 1-57 (Canceled).

58. (Previously Presented) A computer implemented method for providing personalized financial services to a client, the computer implemented method comprising the steps of:

(a) receiving client data from the client comprising at least one client goal and a client portfolio at a depository;

(b) assessing the client portfolio based at least in part on the client goal;

(c) assigning a plurality of services to a plurality of service provider groups, further comprising the steps of:

(i) determining whether each service is needed by the client on a frequent basis;

(ii) determining whether a level of value to the client is above a predetermined level; and

(iii) categorizing the plurality of services into a core service provider group, an affiliated service provider group and a non-affiliated service provider group, wherein the step of categorizing is based at least in part on the steps of determining wherein the steps of assessing and assigning are performed at a server;

and

(d) providing services in a hierarchical manner from the core service provider group, the affiliated service provider group and the non-affiliated service provider group in response to the received client data through a display.

59. (Previously Presented) The method of claim 58, wherein the core service provider group represents services needed by the client on a frequent basis or having a level of value above the predetermined level indicating a primary level of service.

60. (Previously Presented) The method of claim 59, wherein the non-affiliated service provider group represents services needed by the client on an infrequent basis or having a level of value below the predetermined level indicating a secondary level of service.

61. (Previously Presented) The method of claim 60, wherein the affiliated service provider group represents services that do not fall within the core service provider group and the non-affiliated service provider group indicating an intermediary level of service.

62. (Previously Presented) The method of claim 58, wherein the core service provider group represents services most common to the client or providing most value to the client.

63. (Previously Presented) The method of claim 58, wherein the nonaffiliated service provider group represents services least common to the client or providing a small value to the client.

64. (Previously Presented) The method of claim 58, wherein services from the core service provider group are presented to the client; wherein services from the affiliated service provider group and services from the non-affiliated service provider group are presented after the services from the core service provider group are first presented.

65. (Previously Presented) The method of claim 58, wherein the services comprise a plurality of asset allocation services; investment management services; investment banking services; banking services; custody services; reporting services; tax advice services; filing of



federal, state and local tax statement services; estate planning services; legal services; accounting services; bookkeeping services; record keeping services; financial investment services; managing financial assets services; management and other services related to closely held stock services; international trusts services; real estate service; public relations services; crisis management services; selection and delivery of insurance services; physical security services; personal security services; information security services; lease, purchase or fractional ownership of automobiles, planes, vehicles or yachts services; personal concierge services; bill paying services; coordination and direction of charitable activities services; background checks on personal staff or other parties services; offering of investment opportunities not available to non-clients services; development and execution of debt reduction strategies services; development and maintenance of education funds services; advice and care of minors, invalids, elderly, incompetents or other persons services; business succession planning services; issuance of loans, traveler's checks, foreign currency, credit or other banking services.

66. (Previously Presented) A system for providing personalized financial services to a client, the system comprising:

a depository for receiving client data from the client comprising at least one client goal and a client portfolio;

a server for assessing the client portfolio based at least in part on the client goal and assigning a plurality of services to a plurality of service provider groups, wherein whether each service is needed by the client on a frequent basis is determined and whether a level of value to the client is above a predetermined level is determined; wherein the plurality of services are

categorized into a core service provider group, an affiliated service provider group and a non-affiliated service provider group based at least in part on the steps of determining; and

a display for providing services in a hierarchical manner from the core service provider group, the affiliated service provider group and the non-affiliated service provider group in response to the received client data.

67. (Previously Presented) The system of claim 66, wherein the core service provider group represents services needed by the client on a frequent basis or having a level of value above the predetermined level indicating a primary level of service.

68. (Previously Presented) The system of claim 67, wherein the non-affiliated service provider group represents services needed by the client on an infrequent basis or having a level of value below the predetermined level indicating a secondary level of service.

69. (Previously Presented) The system of claim 68, wherein the affiliated service provider group represents services that do not fall within the core service provider group and the non-affiliated service provider group indicating an intermediary level of service.

70. (Previously Presented) The system of claim 66, wherein the core service provider group represents services most common to the client or providing most value to the client.

71. (Previously Presented) The system of claim 66, wherein the nonaffiliated service provider group represents services least common to the client or providing a small value to the client.

72. (Previously Presented) The system of claim 66, wherein services from the core service provider group are presented to the client; wherein services from the affiliated service

provider group and services from the non-affiliated service provider group are presented after the services from the core service provider group are first presented.

73. (Previously Presented) The system of claim 66, wherein the services comprise a plurality of asset allocation services; investment management services; investment banking services; banking services; custody services; reporting services; tax advice services; filing of federal, state and local tax statement services; estate planning services; legal services; accounting services; bookkeeping services; record keeping services; financial investment services; managing financial assets services; management and other services related to closely held stock services; international trusts services; real estate service; public relations services; crisis management services; selection and delivery of insurance services; physical security services; personal security services; information security services; lease, purchase or fractional ownership of automobiles, planes, vehicles or yachts services; personal concierge services; bill paying services; coordination and direction of charitable activities services; background checks on personal staff or other parties services; offering of investment opportunities not available to non-clients services; development and execution of debt reduction strategies services; development and maintenance of education funds services; advice and care of minors, invalids, elderly, incompetents or other persons services; business succession planning services; issuance of loans, traveler's checks, foreign currency, credit or other banking services.

74. (Previously Presented) The system of claim 66, further comprising one or more of a tool for mining data and a synthetic logic tool for assessing the client portfolio.

75. (Previously Presented) The system of claim 74, wherein the synthetic logic tool converts data into useful information related to the at least one client goal.